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EXAMINER

PEACHES, RANDY

ART UNIT

PAPER NUMBER

2686

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/663,387 | Applicant(s) EASO ET AL | |
| | Examiner Randy Peaches | Art Unit 2686 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/128/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, ***claim 7*** recites the broad limitation, "a plurality of cells", and the claim also recites, "at least one cell ***is,***" which is the narrower statement of the range/limitation.

Claims 3-4, 6, 12-14, 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Although the Applicant vaguely discloses in the Specification on page 5 lines 5-9 where a fake call control connection is originated in parallel to the said MT-LR request, no representation is indicated in the

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referenced figures; thus, hampering one of ordinary skill in the art to clearly interpret the Applicant's claimed language.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. ***Claims 1-2, 5, 7-10 and 15*** are rejected under 35 U.S.C. 102(e) as being anticipated by Ignatius et al. (U.S. Patent Publication Number 2005/0043041 A1).

Regarding ***claim 1***, Ignatius et al. discloses communications network comprising:

- a plurality of Mobile Subscriber (MS) units. See paragraph {0042};
- at least one base transceiver station (BTS), each BTS communicating wirelessly with ones of said MS units in a network cell. See paragraph {0041};
- at least one mobile switching center (MSC) administering to said at least one BTS and to any neighboring ones of said at least one MSC. See paragraph {0044}; and
- at least one Gateway Mobile Location Center (GMLC) supporting location services (LCS) and providing an access node for LCS service requests, wherein

requests for services from one MS unit of said plurality of MS units are not placed on hold until a LCS request to said one MS unit completes. The Examiner interprets the above language where the functionality of the said LCS simultaneously processes the location request and other functions. Ignatius et al. discloses such occurrence in paragraph {0052}.

Regarding **claim 2**, according to **claim 1**, Ignatius et al. continues to disclose wherein a response to said request for services is provided to one MS unit before a response is provided for said LCS request. Ignatius et al. inherently provides support of the above language; in that, prior to the user initiating a request, a response regarding the presence of the said user in the area of the receiving base station is received by the said user equipment (MS). See paragraphs {0042 and 0044}.

Regarding **claim 5**, according to **claim 1**, Ignatius et al. continues to disclose:

- a Serving Mobile Location Center (SMLC) performing positional measurement for said plurality of MS units. See paragraph {0047}, wherein Ignatius et al. details in the given paragraph that the different (which includes SMLC) means of processing information for the position.

Regarding **claims 7 and 15**, according to **claims 1 and 10**, Ignatius et al. continues to disclose wherein said at least one cell is a plurality of cells, and said LCS service requests comprise requests for value added services, emergency services and legal

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and lawful interception services. See paragraph {0061}.

Regarding **claim 8**, according to **claim 1**, Ignatius et al. continues to disclose wherein said LCS service requests are mobile terminating location request (MT-LR) and said requests for services are mobile originated (MO) requests, wherein Ignatius et al. details in paragraph {0007} that a user equipment sends a request for location.

Regarding **claim 9**, according to **claim 1**, Ignatius et al. continues to disclose wherein said wireless communications network is a Global System for Mobile Communication (GSM) network. See paragraph {0040}.

Regarding **claim 10**, Ignatius et al. discloses a wireless communications network comprising:

- a plurality of Mobile Subscriber (MS) units. See paragraph {0042}.
- a plurality of base transceiver stations (BTSSs), each BTS in a network cell communicating wirelessly with ones of said MS units in said cell. See paragraph {0041};
- a plurality of base station controllers (BSCs) administering to ones of said plurality of BTSSs;
- a plurality of mobile switching centers (MSC) administering to said plurality of BSCs and to any neighboring ones of said plurality of MSCs;

- at least one Gateway Mobile Location Center (GMLC) supporting location services (LCS) and providing an access node for LCS service requests, wherein requests for services from one MS unit of said plurality of MS units are not placed on hold until a LCS request to said one MS unit completes. The Examiner interprets the above language where the functionality of the said LCS simultaneously processes the location request and other functions. Ignatius et al. discloses such occurrence in paragraph {0052}.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. ***Claims 16-17 and 23-25*** are rejected under 35 U.S.C. 102(b) as being anticipated by “*Digital Cellular Telecommunications Systems (GSM); Universal Mobile Telecommunications System (UMTS); Functional Stage 2 Description of Location Services*”, hereinafter referenced as “*3GPP*”.

Regarding ***claim 16***, 3GPP discloses a method of managing a wireless communications network, said method comprising the steps of:

- initiating a mobile terminating location request (MT-LR) for a particular mobile subscriber (MS) unit. See section 9.1.1 and FIGURE 9.1;

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- idling the mobility management (MM) layer of said particular MS unit. See Section 8.3.1.1;
- initiating a mobile originated (MO) request for services from said particular MS unit. See section 9.2.1.1 and FIGURE 9.7;
- processing said MO request. See section 9.2.1.1; and
- providing a response to said MT-LR. See FIGURE 9.7.

Regarding **claim 17**, according to **claim 16**, the 3GPP continues to disclose wherein said response is provided in step (e) to said MT-LR after a response is provided to said MO request. See FIGURE 9.1.2.

Regarding **claim 23**, according to **claim 16**, the 3GPP continues to disclose wherein a wherein said MT-LR is a request for location service (LCS). See section 9.1.2.

Regarding **claim 24**, according to **claim 16**, the 3GPP continues to disclose said request for LCS provides tracking data for a mobile subscriber. See section 9.1.2.

Regarding **claim 25**, according to **claim 16**, the 3GPP continues to disclose wherein said wireless communications network is a Global System for Mobile Communication (GSM) network. See page 14, 1st paragraph.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. ***Claim 11*** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ignatius et al. (U.S. Patent Publication Number 2005/0043041 A1) in view of *"Digital Cellular Telecommunications Systems (GSM); Universal Mobile Telecommunications System (UMTS); Functional Stage 2 Description of Location Services."*, hereinafter referenced as *"3GPP"*.

Regarding ***claim 11***, according to ***claim 10***, Ignatius et al. discloses a wireless communications network comprising:

- a plurality of Mobile Subscriber (MS) units. See paragraph {0042}.
- a plurality of base transceiver stations (BTSSs), each BTS in a network cell communicating wirelessly with ones of said MS units in said cell. See paragraph {0041};
- a plurality of base station controllers (BSCs) administering to ones of said plurality of BTSSs;

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- a plurality of mobile switching centers (MSC) administering to said plurality of BSCs and to any neighboring ones of said plurality of MSCs;
- at least one Gateway Mobile Location Center (GMLC) supporting location services (LCS) and providing an access node for LCS service requests, wherein requests for services from one MS unit of said plurality of MS units are not placed on hold until a LCS request to said one MS unit completes. The Examiner interprets the above language where the functionality of the said LCS simultaneously processes the location request and other functions. Ignatius et al. discloses such occurrence in paragraph {0052}.
- wherein said wireless communications network is a Global System for Mobile Communication (GSM) network. See paragraph {0040}.

However, Ignatius et al. fails to clearly disclose wherein responses to said MO requests are provided before a response is provided for a corresponding said MT-LR.

The "3GPP", details in figure 9.1.2 the process in which the said MO requests are provided before a response is provided for a corresponding said MT-LR.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teaching of Ignatius et al. to include the teachings of the 3GPP in order to provide a system capable of simultaneously processing the location request from the network and the service request of the originating mobile station.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (571) 272-7914. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Randy Peaches
July 20, 2005


CHARLES APPIAH
PRIMARY EXAMINER